

Amendment  
Serial No. 10/621,589

REMARKS

Claims 1-14 are pending in the application. Claims 1, 3-6, and 9-11 stand rejected. Claim 2 is canceled without prejudice or a disclaimer. Claims 1 and 7 are independent claim.

Each of claims 1 and 2 are amended to correct any grammatical and/or typographical errors and to conform the language of the claims to idiomatic English. In the process, the Applicant did not add and/or delete features from claims 1 and 2. As the Applicant did not add and/or delete features from features to claims 1 and 2, the amendment does not necessitate a new search.

The Applicant respectfully requests entry of the amendments.

The Applicant wishes to thank the Examiner for allowing claims 7, 8, and 12-14.

The Applicant makes minor changes to claim 7 and 8, correcting grammatical and typographical errors, and conforming the language of each claim to idiomatic English. The Applicant does not narrow or enlarge the scope of claims 7 and 8.

The Applicant respectfully requests allowance of claims 7 and 8, as amended, and claim 12-14.

The Applicant also wishes to thank the Examiner for indicating claim 2 would be patentable if rewritten as independent claim incorporating all features of the base claim.

At this time, the Applicant wishes to defer rewriting claim 2 as an independent claim incorporating all features of claim 1, as claim 1, the base claim, appears patentable.

Claim 1 stands rejected under 35 U.S.C. '103(a) as allegedly being obvious over Hidenori *et al.* (J.P. Pub. 11-087815) ("Hidenori") in view of in view of Shimomura *et al.* (U.S. Pub. 2003/0048507) ("Shimomura").

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Claim 1 recites "an optical path converter being configured to output the pumping lights generated and received from the pumping-light generation section to the multiplexing port of the wavelength-division multiplexer/demultiplexer..."

To reject a claim under section 103, the United States Court of Appeals for the Federal Circuit requires a showing of an unrebutted *prima facie* case of obviousness (*In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998)). According to the section 2143.03 of the Manual for Patent Examining Procedure (the "MPEP"), the *prima facie* case cannot be established unless the references cited by the Patent Office, alone or in combination, teach all features recited in the claim (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970)).

In rejecting claim 1, the Patent Office indicates that Hidenori fails to teach an optical path converter of claim 1 (the present Office Action, page 4, line 1-5). Claim 1, however, is not patentable, according to the Patent Office, as Shimomura remedies the deficiencies of Hidenori by teaching a circulator (60), which the Patent Office equates with the optical path converter of claim 1, and as the combination of Hidenori and Shimomura teaches all features of claim 1.

The Applicant respectfully submits that Hidenori, as acknowledged by the Patent Office, does not disclose "an optical path converter being configured to output the pumping lights generated and received from the pumping-light generation section to the multiplexing port of the wavelength-division multiplexer/demultiplexer...," as recited in claim 1.

Shimomura, as read by the Applicant, teaches a wavelength-multiplexed optical add-drop multiplexer containing a circulator 60 (FIG. 15). The circulator 60, however, is neither equivalent to the optical path converter of claim 1 nor teaches the optical path converter of claim 1.

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In particular, Shimomura explicitly teaches that the circulator 60 is not configured to output the received pumping light to the wavelength-division multiplexer/demultiplexer (FIG. 15). The circulator 60, instead, is configured (1) to receive any pump light generated by the excitation light sources 31-34 from the optical multiplexer/demultiplexer 410 and (2) to output any excitation light received from the optical multiplexer/demultiplexer 410 to the third transmission line 121, away from the multiplexer/demultiplexer 410 (id.).

Accordingly, the circulator 60 of Shimomura has different configuration or structure compared to the optical path converter of claim 1, and Shimomura, by teaching the optical circulator 60, does not teach "an optical path converter being configured to output the pumping lights generated and received from the pumping-light generation section to the multiplexing port of the wavelength-division multiplexer/demultiplexer...," as recited in claim 1.

As both Hidenori and Shimomura fail to teach the optical path converter of claim 1, Hidenori, Shimomura, and their combination fail to teach the optical path converter of claim 1. As such, Hidenori, Shimomura, and their combination fail to teach all features of claim 1 or render claim 1 obvious.

The Applicant respectfully submits that to reject claim 1 as being obvious over the combination of Hidenori and Shimomura despite the fact that Hidenori and Shimomura fail to teach the optical path converter of claim 1 and/or Hidenori and Shimomura teaches a circulator that has different configuration or structure is to "use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," a rejection clearly prohibited by the Federal Circuit (*In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998)). Claim 1, therefore, is not obvious over Hidenori, Shimomura, and their combination.


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The Applicant respectfully requests withdrawal of the rejection to claim 1.

Other claims in this application are each dependent on the independent claims 1 and 7 and believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

Should the Examiner deem that there are any issues which may be best resolved by telephone, please contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

  
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Date: May 21, 2007

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